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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,596	06/08/2007	Rene Schenk	10191/4405	4521
26646	7590	10/14/2010	EXAMINER	
KENYON & KENYON LLP			COYER, RYAN D	
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			ART UNIT	PAPER NUMBER
			2191	
			MAIL DATE	DELIVERY MODE
			10/14/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,596	<b>Applicant(s)</b> SCHENK ET AL.	
	<b>Examiner</b> Ryan D. Coyer	<b>Art Unit</b> 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/7/2006; 12/10/2009</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in response to application 10/588596, filed on 6/8/2007. Claims 17-33 are pending in the application, of which claims 17, 27, and 32 are in independent form. Claims 1-16 were canceled in a preliminary amendment.

### ***Claim Objections***

Claims 17-26, 28, and 32-33 are objected to because of the following informalities: on information and belief, the claimed term “configuring” is not a valid English word. Examiner will interpret the term as if it were replaced with the word “configuring.” Additionally, claim 19 is grammatically incorrect. Appropriate correction or clarification is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "the at least one hardware property" lacks antecedent basis because none of the parent claims recite a “hardware property.” Examiner will interpret the instant claim as if the aforementioned limitation were amended to read “at least one hardware property.” Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-28 are rejected as being directed toward non-statutory subject matter, namely software per se. The instant claims recite a “software system” that appears to nothing more than a series of software instructions. The claims recite no hardware. Applicant is directed to explicitly recite hardware and a substantial association between said hardware and the claimed “software system.”

Claim 29 is rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. More specifically, the instant claims are rejected under 35 U.S.C. 101 because the claimed “storage medium” may be interpreted as comprising non-statutory propagation media. The term “storage medium” is not defined in the specification, and the claim language does not preclude an interpretation of the claimed “medium” as a non-statutory propagation medium. To overcome this rejection, Applicant is directed to amend the instant claims to recite a “non-transitory computer readable medium.”

Propagation media (also known as transmission or communication media) includes coaxial cables, copper wires and fiber optics, including the wires that comprise the bus. Propagation media can also take the form of carrier waves, i.e., electromagnetic waves that can be modulated, as in frequency, amplitude, or phase, to transmit information signals. Additionally, propagation media can take the form of acoustic or light waves, such as those generated during radio wave and infrared data

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communications. Finally, propagation media may be seen, felt, or heard, and therefore may be deemed tangible. As such, the instant claims as written, and when viewed in light of Applicant's specification, are not limited to statutory subject matter and therefore are non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-18, 20-21, and 27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson, USPAT 5,872,977, hereinafter "Thompson."

Regarding claim 17, Thompson anticipates "[a] method for configuring a computer program including at least one functional unit, comprising:

**at least one of:** [NB: only one of the following two limitations needs to be present in the prior art for purposes of anticipation] **creating at least one implementation-independent configuration data file**, (see, e.g., Thompson, fig. 2-4, col. 2 ln. 58 – col. 3 ln. 10; ". . . building a platform dependent makefile from a platform independent 'build' file") **and altering information filed in the at least one implementation-independent configuration data file;** (see, *id.*, to add information to a file is to alter the set of information contained in that file)

**at least one of** [NB: only one of the following three limitations needs to be present in the prior art for purposes of anticipation]

**automatically setting-up and automatically updating configuration data, stored in a configuration data container, as a function of the information filed in the at least one implementation-independent configuration data file;** (see, e.g., Thompson, fig. 2-4, col. 3 ln. 2-11; “. . . internal data structure . . .”)

**automatically generating at least one implementation-dependent configuration data file as a function of the configuration data stored in the configuration data container;** (see, e.g., Thompson, fig. 2-4; col. 2 ln. 58 – col. 3 ln. 10; “. . . building a platform dependent makefile from a platform independent ‘build’ file”) **and**

**automatically configuring the at least one functional unit as a function of information filed in the at least one implementation-dependent configuration data file.”** (see, e.g., Thompson, col. 2 ln. 46-48; “. . . form the executable program . . .”).

Regarding claim 18, Thompson anticipates “[t]he method as recited in Claim 17, further comprising:

**automatically generating at least one item of dependency information that describes a dependency on at least two configuration data present in the configuration data container;** (see, e.g., Thompson, fig. 2-4, col. 4 ln. 40-44; col. 5 ln. 36; col. 7 ln. 23-24; “. . . dependency engine . . .”) **and**

**generating the at least one implementation-dependent configuration data file as a function of the at least one item of dependency information.”** (see *id.*, “. . .

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form the platform dependent makefiles . . .”; the makefiles are formed based at least in part on dependency information evaluated by the dependency engine)

Regarding claim 20, Thompson anticipates “[t]he method as recited in Claim 17, further comprising:

**generating a plurality of implementation-dependent configuration data files, and assigning each of the implementation-dependent configuration data files to at least one functional unit.”** (see, e.g., Thompson, col. 4 ln. 20-30; “. . . plurality of platform specific makefiles . . .”).

Regarding claim 21, Thompson anticipates “[t]he method as recited in Claim 20, wherein the at least one implementation-dependent configuration data file is generated as a function of at least one property of hardware on which an installation of at least a portion of the configured computer program is to be made possible.” (see, e.g., Thompson, col. 4 ln. 29-30; “. . . the invention is configured to include platform specific information for which it is used . . .”)

Regarding claims 27-28, the scope of the instant claims does not differ substantially from that of claims 17-18. The instant claims are system analogs of method claims 17-18. Accordingly, the rejection of claims 17-18 apply, *mutatis mutandis*, to claims 27-28.

Regarding claim 29, Thompson anticipates “[t]he software system as recited in Claim 27, wherein the software system is stored in a storage medium.” (See, e.g., Thompson, fig. 1).

Regarding claim 30, Thompson anticipates “[t]he software system as recited

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**in Claim 27, wherein the software system is stored in one of a random access memory, a read-only memory, and a flash memory.”** (See, e.g., Thompson, fig. 1).

Regarding claim 31, Thompson anticipates “[t]he software system as recited in Claim 27, wherein the software system is stored on one of a digital versatile disk, a compact disk, and a hard disk.” (See, e.g., Thompson, fig. 1).

Regarding claim 32, the scope of the instant claim does not differ substantially from that of claim 17. The instant claim is a “computing element” analog of method claim 17. Accordingly, the rejection of claim 17 applies, *mutatis mutandis*, to claim 32.

Regarding claim 33, Thompson anticipates “[t]he computing element as recited in Claim 32, wherein the computing element corresponds to a control device.” (See, e.g., Thompson, col. 2 ln. 59-64; “multiple types of computer platforms”; a computer platform is an equivalent of a control device).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.



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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19, 22-23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson.

Regarding claim 19, Thompson anticipates “[t]he method as recited in Claim 17,” but does not explicitly disclose the limitations “**further comprising: creating a plurality of implementation-independent configuration data files is created; and assigning each of the implementation-independent configuration data files to at least one functional unit.**” However, the subject matter described in the instant claim was well known at the time of the invention and one of ordinary skill in the art would have found it obvious to combine with Thompson the act of creating multiple platform-independent makefiles, each corresponding to a different functional unit (i.e., program). A source of motivation would have been the ability to practice the invention on more than one source program. Accordingly, the instant claim is unpatentable over Thompson.

Regarding claim 22, Thompson anticipates “[t]he method as recited in Claim 20,” but does not explicitly disclose the limitation “**wherein the at least one implementation-dependent configuration data file is generated as a function of a result of a plausibility check.**” However, the subject matter described in the instant claim was well known at the time of the invention and one of ordinary skill in the art would have found it obvious to combine with Thompson the performance of perform a plausibility check, which the Examiner construes as an equivalent of a compatibility

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check, prior to creating a makefile for compiling a program for a given platform. A clear benefit of so doing would have been the ability to avoid compiling programs for platforms with which the programs would be incompatible. Accordingly, the instant claim is unpatentable over Thompson.

Regarding claim 23, Thompson anticipates “[t]he method as recited in Claim 22,” but does not explicitly disclose the limitations “**wherein at least one hardware property is used for carrying out the plausibility check.**” However, the subject matter described in the instant claim was well known at the time of the invention and one of ordinary skill in the art would have found it obvious to combine with Thompson the performance of a plausibility check based on hardware information, which the Examiner construes as an equivalent of a compatibility check based on hardware information, prior to creating a makefile for compiling a program for a given platform. A clear benefit of so doing would have been the ability to avoid compiling programs for platforms with which the programs would be incompatible. Accordingly, the instant claim is unpatentable over Thompson.

Regarding claim 26, Thompson anticipates “[t]he method as recited in Claim 17,” but does not explicitly disclose the limitations “**further comprising: automatically determining, as a function of the configuration data, whether a functional unit included by the computer program is needed by the computer program, wherein the functional unit is only configured if the functional unit is needed by the computer program.**” However, the subject matter described in the instant claim was well known at the time of the invention and one of ordinary skill in the art would have

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found it obvious to combine with Thompson the operation of referencing in a makefile and compiling only necessary elements of a software application. A clear source of motivation for so doing would have been the realization of smaller code size and faster compilation times. Accordingly, the instant claim is unpatentable over Thompson.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Pramberger, USPGPUB 2002/0040469, hereinafter "Pramberger."

Regarding claims 24-35, Thompson anticipates "[t]he method as recited in **Claim 20,**" but does not explicitly disclose the limitations **"further comprising: automatically creating a documentation that describes the information filed within at least one of the at least one implementation-independent configuration data file and the at least one implementation-dependent configuration data file"** and wherein **"implementation-independent configuration data file is created in an XML-based format."** However, Pramberger discloses the subject matter of the instant claims in paragraph 16 ("Further, XSCML based definitions may be processed to create an environment documentation to be printed or accessible via the Web. This leads to environment definitions which, on the one side, describe the technical constructs needed for running the software configuration environment system, but also provide a self documenting approach of the same. To enhance the documentation capabilities, additional XML tags may be allowed similar to the

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HTML (hypertext markup language) tags to intersect the technical text to provide the commentary of the technical elements, on one side, but also allow to create user and administration documentation, on the other side, from the same source.”)

Pramberger and Thompson are both directed toward the field of software engineering and therefore are analogous art. At the time of the invention, one of ordinary skill in the art would have deemed it obvious to combine the documentation and XML formatting teachings of Pramberger with the makefile generation method of Thompson. XML is a very common format, the use of which would render documentation readable to most users. Moreover, documentation in general is very useful for describing, *inter alia*, the software components included in a compilation operation. Accordingly, the instant claims are obviated by Thompson in view of Pramberger.

### ***Conclusion***

The prior art made of record on form PTO-892, 'Notice of References Cited', but not relied upon in the above rejections, is considered pertinent to applicant's disclosure. The aforementioned prior art addresses subject matter disclosed in the specification but not necessarily presented in the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN D. COYER, whose telephone number is (571) 270-5306, and whose fax number is (571) 270-6306. The examiner normally may be reached via phone on Mon-Thurs, 9a-8p. If attempts to reach the examiner by

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telephone are unsuccessful, the examiner's supervisor, Wei Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan D. Coyer/  
Examiner, Art Unit 2191

/Wei Y Zhen/  
Supervisory Patent Examiner, Art Unit 2191